

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

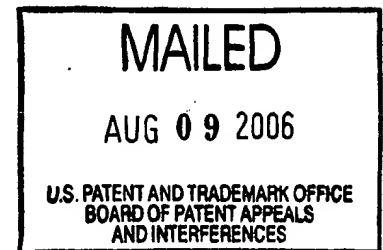
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG W. BARNETT,
KAREN R. REISNER AND MARK BRAUNSTEIN

Appeal No. 2005-2686
Application No. 09/879,823

ON BRIEF



Before JERRY SMITH, GROSS, and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider our decision of February 8, 2006 wherein we sustained the rejection of claims 47-62 as being based on an inadequate disclosure, and wherein we sustained the rejection of claims 47-62 as being anticipated by Von Kohorn under 35 U.S.C. § 102. Appellants also request that, in the alternative, we designate our decision a new ground of rejection under 37 CFR § 41.50(b) based on our reliance on different portions of Von Kohorn than were used by the examiner in sustaining the examiner's rejection.

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Appellants argue that the rejection of claim 61 under the first paragraph of 35 U.S.C. § 112 was improperly sustained because claim 61 does not recite the elements for which no support in the specification was found in the original decision [request, page 7].

We agree with appellants and regret the oversight. We vacate that portion of our decision which held that claim 61 failed to comply with the first paragraph of 35 U.S.C. § 112. Therefore, the examiner's rejection of claims 47-62 under the first paragraph of 35 U.S.C. § 112 is still sustained with respect to claims 47-60 and 62-67, but is not sustained with respect to claim 61.

Appellants argue that the Board acknowledged that the examiner did not rely on the best portions of Von Kohorn and that the Board relied on a different portion of Von Kohorn in sustaining the examiner's rejection. Appellants argue that the decision should be designated as a new ground of rejection so that appellants have a fair opportunity to respond to these new findings [request, pages 7-9].

Although a reference cited as prior art is considered to be cited in its entirety, the designation of a new ground of

rejection is based on fundamental fairness to appellants. Since Von Kohorn is an extremely large reference with several different embodiments disclosed therein, we agree with appellants that they had a right in this case to rely on the specific portions of the reference cited by the examiner. Since we basically agreed with appellants that some portions of Von Kohorn relied on by the examiner did not support the examiner's findings, we agree with appellants that fundamental fairness requires that we designate our decision in this case with respect to the anticipation rejection as a new ground of rejection under 37 CFR § 41.50(b).

Appellants argue that the new portions of Von Kohorn relied on in the decision on appeal do not support the findings of anticipation as set forth in the decision [request, pages 10-17]. First, appellants argue that the portions of Von Kohorn cited in the Board's decision do not disclose "targeting." Appellants support this argument by citing a different portion of Von Kohorn than the portion cited in the Board's decision [request, pages 10-14].

We are not persuaded of error by this argument. First, appellants cite a portion of Von Kohorn which follows the statement "[i]n accordance with a further aspect of the

invention" [column 99, line 18]. Thus, appellants are citing a portion of Von Kohorn which is a different embodiment than the one relied on in the Board decision. Second, the portion of Von Kohorn relied on by the Board specifically states that participants can designate areas of interest and receive coupons related to the area of interest. Therefore, these participants are targeted for receiving coupons in the area of interest. Only participants having designated this area of interest receive these coupons in this embodiment.

Appellants also argue that the decision fails to address the "monitoring redemption" element of the claimed invention. Appellants additionally argue that the recitations of dependent claims 51 and 56 are not met by Von Kohorn [request, pages 14-17].

These arguments were addressed to the extent that they were made in the briefs. Appellants are not permitted to have arguments considered in a request for rehearing that were not made in the briefs.

Appellants argue that our decision in this case conflicts with the decision in a related appeal [request, pages 17-18]. We regret that the decision in the related appeal was made before the Board had fully grasped all the teachings of Von Kohorn.

Unfortunately, the Board in the related appeal relied on the same portions of Von Kohorn cited by the examiner that were found to be deficient. A subsequent review of Von Kohorn finds that Von Kohorn supports the rejection for reasons noted in the original decision in this case and for reasons discussed above.

Appellants argue that the Board has inconsistently interpreted the phrase "predetermined number of times" for purposes of finding anticipation under 35 U.S.C. § 102(b) and lack of written description under 35 U.S.C. § 112. Appellants assert that the Board failed to point to any express disclosure in Von Kohorn of limiting use of a coupon to a "predetermined number of times" [request, pages 18-20].

First, it is noted that the standards for support of a claimed invention under the first paragraph of 35 U.S.C. § 112 and for disclosure of the invention by the prior art are not the same. As was discussed in the original decision, appellants' specification does not provide support for the breadth of the phrase "predetermined number of times," but the phrase is met by the number one. Since the printed coupons in Von Kohorn can only be redeemed one time, Von Kohorn discloses the invention when given its broadest interpretation which is also consistent with

what appellants' specification supports. The interpretation of the phrase argued by appellants is not supported by appellants' specification.

Appellants argue that the Board improperly read the condition of fraud into the claimed invention for purposes of considering whether the phrase a "predetermined number of times" was supported by appellants' specification [request, pages 20-23]. We are not persuaded by this argument. The decision in this case simply dismissed appellants' proposed second meaning of the phrase a "predetermined number of times" because the specification teaches that a coupon can only be redeemed once as a measure to prevent fraud. The decision simply notes that the meaning of the phrase proposed by appellants would not perform the important function of fraud protection as taught by the disclosure.

In summary, we have granted appellants' request for rehearing to the extent that we have vacated our decision with respect to sustaining the rejection of claim 61 under 35 U.S.C. § 112, and that we have designated our sustaining of the rejection of all claims under 35 U.S.C. § 102(b) as a new ground of rejection under 37 CFR § 41.50(b). The request for rehearing is denied with respect to all other issues raised in the request.

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In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the

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affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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